In the Supreme Court of the United States

OCTOBER TERM, 1945

R. G. LETOURNEAU, INC.,
Petitioner,

vs.

GAR WOOD INDUSTRIES, INC.,
Respondent.

Brief in Support of the Foregoing Petition for Certiorari

This is a Petition for Review on Writ of Certiorari of the decision of the Circuit Court of Appeals for the Ninth Circuit in the case of R. G. LeTourneau, Inc. vs. Gar Wood Industries, Inc.; the opinion being reported in 151 Fed. (2d) 432 and appearing in the Transcript of Record, pages 672 to 681.

The decision of the United States District Court for the Northern District of California, Southern Division, which was affirmed is reported in 51 Fed. Supp. 977, and appears in the Transcript of Record, pages 53 to 57.

THE JURISDICTION

The decree of the Circuit Court of Appeals for the Ninth Circuit, a review of which is sought by this Petition for a Writ of Certiorari, was filed and entered on October 19, 1945 (Transcript of Record, page 681). The judgment of the District Court, affirmed by the aforesaid decree, was filed and entered on November 2, 1943 (Transcript of Record, page 64).

The judicial discretion of this Court is invoked under the provisions of the United States Code, Title 28, Section 347(a), and of Rule 38 of this Court.

The single question which it is sought to have reviewed and determined by this Court is as follows:

> Where invention was required to conceive the idea of combining old elements to produce an improved result, thereby providing a machine of greater utility; but, given the inventive conception, it was more a matter of mechanical skill than of invention to devise an embodiment of it, has a patentable invention been made?

A negative answer to this question was the *sole* basis of the decision a review of which is sought.

The reasons relied upon for allowance of the Writ of Certiorari are:

1. The question presented is of great public importance; and
2. The Circuit Court of Appeals has decided the question in a way in conflict with applicable decisions of this Court and with the weight of authority.

STATEMENT OF THE CASE

The decision review of which is sought by this petition was rendered in an action to restrain infringement of United States Letters Patent No. 1,963,665 granted June 19, 1934 to Robert G. LeTourneau and assigned by him to the petitioner R. G. LeTourneau, Inc. and of another patent. Review is sought only as to the LeTourneau patent identified above.

The LeTourneau patent discloses and claims improvements in large capacity, tractor drawn earth moving scrapers which (1) load by digging and scraping up earth from any site; (2) carry the earth in a pair of bowl-like elements supported on wheels; and (3) discharge and grade the earth by automatically causing the respective parts of the load carried by the two bowls to be discharged *sequentially* (as distinguished from *simultaneously*) into the path of a grading blade susceptible of vertical adjustment so as to level off the discharged earth to any desired depth.

No previously known scraper provided with similar bowls for loading, carrying and discharging earth had had a mode of operation in which the discharge was automatically caused to take place *sequentially* instead of *simultaneously*. The new mode of operation imparted greater utility to such devices, making possible *inter alia* the positive ejection of muddy adherent earths not susceptible of being readily dumped and the use of tractors less powerful in proportion to the load handled, and hence the handling of larger loads. The LeTourneau invention had great commercial success (Transcript of Record, page 491) and the patent was recognized by petitioner's com-

petitors who sought and received licenses (Transcript of Record, pages 478, 507).

The District Court (Opinion at Transcript of Record, page 53 et seq.) held void for want of invention all claims of the LeTourneau patent charged to be infringed, disregarding the inventive character of the conception of the idea of automatic sequential, as distinguished from simultaneous discharging of the bowls, and ruling that invention could not be found unless one skilled in the art

> "confronted with * * the problem of imparting operating means to actuate the * * auxiliary bowl in advance of any imparting of movement to the rear endgate"* (Transcript of Record, pages 55 and 56),

could not have devised the patented structure.

The Circuit Court of Appeals for the Ninth Circuit affirmed the decision of the District Court on the ground that, in the case of patents for machines producing an *improved* result as distinguished from a result "different in nature" from any result previously achieved, the inventive character of the conception of the idea of a novel mode of operation imparting greater utility was immaterial, saying:

> "when as here a result is not different in nature from results achieved by similar means in the past, invention must be embodied in the means for carrying the abstract idea into effect, not merely in the conception of the idea." (Transcript of Record, page 679.)

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* Which rear endgate positively ejected the contents of the other bowl.

ERROR INTENDED TO BE URGED

The Circuit Court of Appeals for the Ninth Circuit erred in holding that:

> A patentable invention has not been made, even though invention was required to conceive the idea of combining old elements to produce the patented machine if only improved results, as distinguished from a result "different in nature" is achieved, and if given the inventive conception, it was more a matter of mechanical skill than of invention to devise an embodiment of it.

ARGUMENT

Summary.

The public importance of the question presented by this case is evidenced by official statements of committees appointed by and under direction of the President of the United States, as well as by statements of legal commentators.

It is officially stated that the present confusion and uncertainty as to the interpretation of the statutory requirement for "invention" threatens the usefulness of the whole patent system and calls for an immediate and effective remedy.

A decision of this Court in the present case will provide such a remedy applicable to patents on all important improvements in machines.

The decision a review of which is sought is in direct conflict with a decision of this Court which has never been modified or overruled, and is further in direct conflict with the weight of authority in the Third, Sixth, Seventh and

Ninth Circuits and the Court of Customs and Patent Appeals.

The Public Importance of the Question Presented.

A definitive adjudication of the question presented by this case is submitted as being of great public importance because (a) interpretation of the provisions of the patent laws requiring "invention" as a condition precedent to the sustaining of letters patent is destructively uncertain and conflicting in all its phases at this time, and because (b) no single phase of the interpretation of these provisions is of as great public importance as that involved in the question presented by this petition.

The public interest in clarification of these provisions of the patent laws is made plain by the National Patent Planning Commission, established by Executive Order No. 8977 dated December 12, 1941. In its first report made to the President of the United States and transmitted by the President to Congress on June 18, 1943 it is declared:

> "The most serious weakness in the present patent system is the lack of a uniform test or standard for determining whether the particular contribution of an inventor merits the award of the patent grant. * * The difficulty in applying this statute arises out of the presence of the words 'invented' and 'discovered'. * *
> "No other feature of our law is more destructive to the purpose of the patent system than this existing uncertainty as to the validity of a patent. * * The present confusion threatens the usefulness of the whole patent system and calls for an immediate and effective remedy."

Currently continuing public interest in this subject is evidenced by that portion of the Agenda of the Presi-

dent's Committee on the Patent System, made public August 6, 1945, reading as follows:

> "Matters to be considered include: * * (b) whether and to what extent legislation can set forth *positive* factors to be taken into consideration in determining invention (for example, recognition of the need or problem, and unsuccessful efforts to find a solution, by others than the alleged inventor and those associated with him); * * In connection with the foregoing a detailed study should be made (e) of the opinions of the Supreme Court rendered since 1930 in patent infringement cases (together with appropriate examination of the records of such cases) with a view to determining what standard of invention is now being applied by that court and in what terms it has been defined, and (f) of leading decisions of circuit courts of appeals interpreting and applying that standard."

Uncertainty and conflict in judicial interpretations affecting the vital public interest in this field has been multiplied since the decision of this Court in *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U.S. 84; 62 S.Ct. 37. It is quite evident that the lower courts have failed to understand the import of this decision. Some courts professed to recognize a "new doctrinal trend" in the reference to a "flash of genius" being requisite for patentability, while others professed to find therein no modification of the Court's attitude. Legal commentators have reflected this uncertainty and conflict,* which has reached

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* See "Inventive Concept and the Cuno Case", Journal of the Patent Office Society, Volume 24, pages 678-699; "Flash of Genius —Quenched?" Journal of the Patent Office Society, Volume 25,

such a state as to require clarification by this Court of its interpretation of the provisions of the patent laws as to "invention" as the only immediately available and effective remedy for confusion threatening the usefulness of the whole patent system.

The present Petition for a Writ of Certiorari seeks to present to this Court a single question bearing upon a phase of the interpretation of the provisions of the patent laws relating to "invention" more important to the public interest than any other phase thereof.

It is asserted without the possibility of successful contradiction that the vast majority of all machines patented today are improvements on preexisting types of machines, as distinguished from machines achieving ultimate results never before achieved in any degree; that such improvements are made by bringing together old elements in new combinations, and not by the invention of wholly new machine elements; and that the inventive acts resulting in the most important improvements are conceptions of the idea of combining such old elements in a new way, as distinguished from mere exercises of unusual ingenuity in putting the parts of the machine together.

The question presented by this Petition relates to an improvement in a preexisting type of machine, as distinguished from a machine achieving ultimate results never before achieved in any degree; to an improvement made by bringing together old elements in a new combination,

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pages 771-775; "Flash of Creative Genius, An Alternative Interpretation," Journal of the Patent Office Society, Volume 25, pages 776-784; "The 'Flash of Genius' Fallacy," Journal of the Patent Office Society, Volume 25, pages 785-790; "Patentable Yardsticks," Journal of the Patent Office Society, Volume 25, pages 791-818.

rather than by the invention of any wholly new machine element; and presents a situation in which the inventive act which resulted in the improvement was the conception of the idea of combining the old elements in a new way, rather than in an exercise of unusual ingenuity in putting the parts of the machine together.

It is thus demonstrated that the doctrine enunciated by the Circuit Court of Appeals for the Ninth Circuit, that the exercise of invention in conceiving the idea of combining old elements in a new way is not patentable invention where the result achieved is improvement in a pre-existing type of machine, as distinguished from a result never before achieved in any degree, impugns the validity of the vast majority of all machine patents granted today, and removes all incentive for making improvements of the most important kind in existing machinery.

On this basis the public importance of the question is submitted to be such as to warrant review by this Court.

THE CONFLICT WITH APPLICABLE DECISIONS OF THIS COURT AND WITH THE WEIGHT OF AUTHORITY

In holding that the result achieved must be "different in nature", as distinguished from an *improved or superior result* of the same general nature, in order to render applicable the principle for which appellant contends, this Court is in direct conflict with decisions of the United States Supreme Court; and decisions of the Circuit Courts of Appeal for the third, sixth, seventh, and ninth circuits and the Court of Customs and Patent Appeals.

The Circuit Court of Appeals in its opinion evidenced difficulty in deciding upon the principle applicable to the facts, saying in Footnote 3 (Transcript of Record, pages 679 and 680):

> "The line dividing the principle followed herein from that appellant claims is applicable to the instant facts is difficult to define. Cases containing language in support of the principle suggested by the appellant are as follows: National Cash Register Co. v. Boston Cash Indicator and Rec. Co., 156 U.S. 502, 514 (1895); In re Benckner, 96 Fed. 2d 326, 328 (CCPA, 1936); American Steel Foundries v. Damascus Brake Beam Co., 267 Fed. 574, 576 (CCA 7, 1920); Rosemary Mfg. Co. v. Halifax Cotton Mills, Inc., 257 Fed. 321, 322 (CCA 4, 1919); Cunningham Piano Co. v. Aeolian Co., 255 Fed. 897, 900 (CCA 3, 1919); International Co. v. William Cramp & Sons S. & E. Bldg. Co., 211 Fed. 124, 144 (CCA 3, 1914); Los Alamitos Sugar Co. v. Carroll, 173 Fed. 280, 283 (CCA 9, 1909)."

The majority of the cases cited in this footnote of the opinion of this Court were, however, cases in which the patented thing achieved an *improved or superior result* of the same general nature achieved by devices in the prior art as distinguished from a result "different in nature" from any result secured by a device in the prior art.

In *National Cash Register Company v. Boston Cash Indicator and Recorder Co.*, 156 U.S. 502, it was pointed out by the Court at page 513 that

> "the use of keys to raise vertical rods carrying tablets was not only well known, but lies at the foundation of every cash register to which our attention has been called."

That the result achieved by the invention was an improved or superior result of the same general nature as distinguished from a result different in nature from any secured by the prior art devices is made clear by the statement at page 515 that

> "the end or purpose to be accomplished in this case was not the moving of the wing, but the *more perfect* operation of the rods." (emphasis supplied)

Nothing is found at page 515 of this opinion which could refute petitioner's theory as stated in the opinion of the C.C.A. (Transcript of Record, page 680); for the observation in the Supreme Court opinion that "this use of the connecting mechanism can hardly be termed analogous to such as similar mechanisms had been previously used for" is plainly shown to be considered immaterial by the immediately following statement that "but *even if it were,* the results are so important, and the ingenuity displayed to bring them about is such that we are not disposed to deny the patentees the merit of invention". (emphasis supplied)

In *Los Alamitos Sugar Co. v. Carroll,* 173 Fed. 280 (C.C.A. 9, 1909) the result achieved by the patented device is clearly shown to be an improved or superior result of the same general nature as distinguished from a result "different in nature" from that secured by any prior art device by the statement of the Court appearing at page 283.

> "While none of the elements employed by him were new, and while there was nothing new in the mere idea of dumping loads from cars, wagons, and other vehicles by tilting the vehicle sideways and thereby

causing its load to slide out by gravity, there is nothing in the record tending to show that anybody else had ever before thought of so unloading a wagon while the horses remained hitched to it, nor of the novel, expeditious, and highly successful manner employed by Carroll."

In *Cunningham Piano Co. v. Aeolian Co.*, 255 Fed. 897 (C.C.A. 3) the result achieved by the thing patented is clearly shown to have been an improved or superior result of the same general nature as distinguished from a result "different in nature" from any secured by prior art arrangements by the following language of the Court appearing at pages 899 and 900.

"It thus appears very clearly that the art, when Young entered it, called for some musical knowledge and some musical skill on the part of the performer to render artistically a musical composition mechanically sounded. It is equally clear that the art enabled him to render music only according to his own skill, or, at most, only according to his skill in reproducing the interpretation of another so far as that interpretation was shown by words, numerals and by the Webber expression line and its angles."

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"Young's thought that a line might be made to record a master's interpretation of a musical composition, and that anyone, however unskilled, who follows that line physically can reproduce the music of the master just as the master had rendered it, was not his invention. That was his discovery. It was, however, the soul of his invention. The very simple means of a pointer connected with the controller and extending over the music sheet to the line, by which his discov-

ery was brought into action, did not, when standing alone, involve invention. But when this means, simple though it was, was employed to bring into being and put to use the substance of the discovery, the two together, the great and the little thing, constitute invention."

In *American Steel Foundries v. Damascus Brake Beam Co.*, 267 Fed. 574 (C.C.A. 7) it is clearly shown that the patented process and product achieved an improved or superior result of the same general nature as distinguished from a result "different in nature" from that achieved by prior art processes and products by the following language of the Court appearing at pages 575 and 576.

> "The process and product patents here under consideration deal with a 'strut' or 'fulcrum' for trussed brake beams; a forged type being used in place of the more common form of malleable castings."
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> "The problem confronting the patentee was one which called for a merchantable fulcrum, of great strength, of resiliency, using the least possible amount of material, a unitary structure, with one end supplying the seat for the tension member of the brake beam, so located with reference to the arms of the fulcrum as to reduce the possibility of their splitting when strain came to the finished article."

In *In re Benckner,* 96 Fed. (2d) 326 (C.C.P.A.) the invention related to structural improvements in an electrolytic cell of which there were a great many examples in the prior art referred to in the Opinion. It is clear, therefore, that the Benckner structure contemplated nothing more than an improved or superior result of the same gen-

eral nature as distinguished from a result "different in nature" from any secured by the prior art structures.

It is evident from the foregoing decisions that the great weight of authority both in the Supreme Court and in the Circuit Courts of Appeal is that the conception of an abstract idea in an act of invention where the abstract idea involves the combination of old instrumentalities to produce *either* a result "different in nature" or an *improved and superior result* of the same general nature as prior art devices, where the conception of the idea of combining the old instrumentalities is not within the scope of the ordinary workman skilled in the art, and where the idea has been incorporated into a useful machine.

The present decision of this Court is therefore submitted to be directly in conflict with the weight of authority thus evidenced.

Respectfully submitted,

WEBSTER AND WEBSTER,
PERCY S. WEBSTER,
NAYLOR AND LASSAGNE,
THEODORE H. LASSAGNE,
Attorneys for Petitioner.